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2007 DEC 17 PM 5:20
CLERK U.S. DISTRICT COURT
CENTRAL DIST. OF CALIF.
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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

X17, INC., a California corporation,
Plaintiff,

vs.

MARIO LAVANDEIRA, dba Perez
Hilton, and DOES 1 through 10,
inclusive,
Defendants.

CASE NO. CV 06-07608 VBF (JCx)

**DEFENDANT'S MEMORANDUM OF
POINTS & AUTHORITIES IN
SUPPORT OF MOTION FOR
SUMMARY JUDGMENT OR, IN
THE ALTERNATIVE, PARTIAL
SUMMARY JUDGMENT**

Date: January 21, 2008
Time: 1:30 p.m.
Room: 9

TABLE OF CONTENTS

I.	Introduction.....	2
II.	Statement Of Facts.....	2
	A. The Parties	2
	1. Plaintiff X17.....	2
	2. Mario Lavandeira.....	3
	B. X17’s Lawsuit Against Mario Lavandeira.....	3
	C. X17 Reluctantly Produces “Evidence” To Support copyright Ownership At The Preliminary Injunction Phase	4
	D. X17 Identifies Itself As The “Author” Of The Copyrights.....	5
	1. X17 Represents The Photographs as “Works Made For Hire”.....	5
	2. X17 Creates Assignment Agreements For This Lawsuit.....	5
	3. X17 Fails To Disclose The Purported Assignment Agreements To The Copyright Office	7
	4. X17 Did Not Pay Photographers Any Consideration For Signing The Assignments	8
	E. None Of The Photographers Are X17 Employees.....	8
	F. X17 And Lavandeira Are Not Competitors	9
III.	The Summary Judgment Standard	11
IV.	Lavandeira Is Entitled To Summary Judgment On X17’s Copyright Claim.....	11
	A. X17’s Copyright Registrations Are Invalid Because It Falsely Stated To The Copyright Office That The Photographs Were Works Made For Hire	11
	1. The Photographers Were Not Employees Of X17.....	12

2.	The Photographs Were Not Specially Ordered Or Commissioned Works Under Section 101(2)	13
B.	An Invalid Copyright Registration Nullifies The Court’s Subject Matter Jurisdiction In An Infringement Action	14
V.	X17’s Purported Assignment Agreements Do Not Cure X17’s Invalid Registrations	15
A.	X17 Failed To Submit The Assignment Agreements To The Copyright Office	16
B.	Even If It Had Submitted The Assignments, X17 Cannot Use Supplementary Registration To Validate An Invalid Registration	16
C.	For At Least 56 Photographs, The Purported Assignments Occurred After X17 Submitted The Copyright Applications, And Thus Partial Summary Judgment Is Appropriate	17
1.	The January 22, 2007 “Assignments”	18
2.	The Undated November 2006 “Assignments”	18
3.	The Improperly Assigned Photographs	19
VI.	At A Minimum, X17 Is Not Entitled To Statutory Damages, As It Failed To File For Registration Prior To The Alleged Infringement (Or Within The Three Month Grace Period)	20
A.	The Requirements For Statutory Damages And Attorneys’ Fees	20
B.	It Is Undisputed That X17 Cannot Meet The Requirements For Statutory Damages And Attorneys’ Fees On At Least 18 Photographs	20
C.	Partial Summary Judgment Is Appropriate On The Issue Of Statutory Damages And Fees	23
VII.	Lavandeira Is Entitled To Summary Judgment On X17’s “Hot News” Claim	24
VIII.	Conclusion	25

TABLE OF AUTHORITIES

FEDERAL CASES

<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	11
<i>Berlyn, Inc. v. Gazette Newspapers, Inc.</i> , 157 F. Supp. 2d 609 (D.Md. 2001).....	20
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986)	11
<i>Community for Creative Non-Violence v. Reid</i> , 490 U.S. 730, 109 S. Ct. 2166 (1989).....	12
<i>Fred Wehrenberg Circuit of Theatres v. Moviefone</i> , 73 F. Supp. 2d 1044 (E.D. Mo. 1999).....	25
<i>International News Association v. Associated Press</i> , 248 U.S. 215 (1981)	25
<i>Johnson v. Jones</i> , 149 F.3d 494 (6th Cir. 1998)	20
<i>Johnson v. University of Virginia</i> , 606 F. Supp. 321 (D.C.Va. 1985)	23
<i>Konisberg International v. Rice</i> , 16 F.3d 355 (9th Cir. 1994).....	17
<i>Morgan, Inc. v. White Rock Distilleries, Inc.</i> , 230 F. Supp. 2d 104 (D. Me. 2002)	11
<i>In re Napster, Inc. Copyright Litigation</i> , 191 F. Supp. 2d 1087 (N.D.Cal.,2002).....	1
<i>National Basketball Association v. Motorola</i> , 105 F.3d 841 (2d Cir. 1997)	24
<i>Qualey v. Caring Center of Slidell</i> , 942 F. Supp. 1074 (E.D.La. 1996)	23
<i>Rubloff v. Donahue</i> , 31 U.S.P.Q. 2d 1046 (N.D. Ill. 1994)	16
<i>William A. Graham Co. v. Haughey</i> , 430 F. Supp. 2d 458 (E.D.Pa. 2006).....	24

STATE CASES

<i>Torres-Negron v. J&N Records, LLC</i> , Nos. 06-2058, -2059, 2007 WL 2846117 (1st Cir. Oct. 2, 2007)	14
--	----

FEDERAL STATUTES

37 C.F.R. § 201.5	16
-------------------------	----

17 U.S.C. § 101.....	13
17 U.S.C. § 408.....	16
17 U.S.C. § 412.....	20
Fed. R. Civ. P. 56.....	11

MISCELLANEOUS

<i>Restatement (Third) of Unfair Competition, § 38b</i>	25
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1 **I. INTRODUCTION**

2 Plaintiff X17, Inc. has alleged two claims against Mario Lavandeira: (1)
3 copyright infringement; and (2) “hot news” misappropriation. As established below,
4 the uncontroverted facts establish that both claims fail, as a matter of law.

5 X17’s copyright infringement claim fails because this Court lacks subject
6 matter jurisdiction. The Copyright Act provides that “no action for infringement of
7 the copyright in any work shall be instituted until registration of the copyright claim
8 has been made.” As courts in this district have observed, “copyright registration is a
9 jurisdictional prerequisite to an infringement action.”¹ An invalid registration
10 (involving material errors) nullifies the federal court’s subject matter
11 jurisdiction. While X17 has applied for and obtained copyright registrations, none of
12 is valid because X17 made material misrepresentations in each and every
13 application.

14 In particular, X17’s applications submitted to the United States Copyright
15 Office identify X17 as the “author” of the photographs at issue under the doctrine of
16 a “work made for hire.” That representation, however, was entirely false because the
17 uncontroverted facts demonstrate that none of the photographs was the result of the
18 “work for hire” doctrine. There are only two exclusive means to establish a “work
19 made for hire” relationship: (1) a work created by an employee during the course and
20 scope of employment; (2) or certain works “specially ordered or commissioned”
21 pursuant to a written agreement. X17 has not, and cannot, establish either.

22 X17 cannot establish that its employees created the works in the course and
23 scope of their employment because X17 has testified that it has no employees. At
24 their depositions, the photographers confirmed that they were not employees but
25 rather independent contractors.

26 X17 likewise cannot show that it “specially ordered or commissioned” the

27
28 ¹ *In re Napster, Inc. Copyright Litigation*, 191 F.Supp.2d 1087,
1101 (N.D.Cal.,2002).

1 photographs because the photographs at issue do not fall into any of the nine
 2 enumerated categories that may be commissioned. Moreover, X17 has failed to
 3 come forward with any evidence to suggest that it signed “work made for hire”
 4 agreements with the photographers.

5 In light of the foregoing, X17’s representations to the Copyright Office about
 6 copyright authorship were entirely inaccurate. The undisputed facts establish that, in
 7 an effort to save its copyright claim, X17’s litigation attorneys created assignment
 8 agreements that purportedly assigned the rights to the photographs to X17. X17’s
 9 problem, however, is that it has failed to notify the Copyright Office of any of these
 10 alleged assignments. To make matters worse, many of the assignments were signed
 11 after X17 filed its copyright applications. In other words, X17 had no rights
 12 whatsoever when it filed the applications. Even more egregious is the fact that X17
 13 had photographers “transfer” rights to photographs they did not even own.

14 Courts around the country have made it clear that when a party makes material
 15 misrepresentation, as X17 has done here, the copyright registrations are invalid
 16 thereby stripping the court of subject matter jurisdiction. So it is here.

17 X17’s second claim for “hot news” misappropriation also fails because the
 18 uncontroverted facts demonstrate that X17 cannot meet one of the key elements for
 19 the claim: that the parties be “direct competitors.” X17 has testified unequivocally
 20 that it is not in competition with Lavandeira.

21 Lavandeira therefore respectfully requests that this Court grant summary
 22 judgment.

23 **II. STATEMENT OF FACTS**

24 **A. The Parties**

25 **1. Plaintiff X17**

26 X17’s first amended complaint (“FAC”) contends that, since 2001, it “has
 27 owned and operated one of the world’s leading archives of celebrity-related
 28 photographs . . .” (FAC, ¶ 8.) The FAC further alleges that, “[f]or valuable

1 consideration, X17 has licensed the rights to reproduce its copyrighted works in
 2 copies, distribute copies of its copyrighted works, and publicly display copies of its
 3 copyrighted works, or derivative versions thereof, to hundreds of magazines,
 4 newspapers, television stations and other prominent media outlets throughout the
 5 world.” (*Id.*, ¶ 9.) According to X17, it “is particularly renowned for its timely
 6 photographs covering breaking news events and its images of leading stories of the
 7 day.” (*Id.*, ¶ 10.)

8 **2. Mario Lavandeira**

9 Defendant Mario Lavandeira operates a website, www.perezhilton.com, on
 10 which he reports celebrity news. (Declaration of Mario Lavandeira (“Lavandeira
 11 Decl.”), ¶ 3.) As part of the reporting, Lavandeira posts photos that depict
 12 newsworthy events. (*Id.*, ¶ 4.) The photos have all been obtained from public
 13 sources, previously published on the Internet. (*Id.*, ¶ 5.)

14 The photographs Lavandeira posts are almost always accompanied by text that
 15 reports on the events. (Lavandeira Decl., ¶ 6.) While admittedly not always high art,
 16 Lavandeira nonetheless draws on the photos and places commentary directly beneath
 17 them. (*Id.*) He does not use the entire photographs, but rather only portions
 18 necessary to report the news. (*Id.*) The quality of the photographs on the website is
 19 not high and, as such, the photographs are not well suited for copying. (*Id.*)

20 **B. X17’s Lawsuit Against Mario Lavandeira.**

21 On November 30, 2006, X17 filed a complaint alleging copyright infringement
 22 arising out of Lavandeira’s purported use of 52 photographs. (*See* Complaint.)
 23 X17’s complaint attached none of the photographs addressed in the complaint. The
 24 complaint, furthermore, attached no copyright applications or registrations.

25 On January 5, 2007, Lavandeira filed his answer, which asserted “fair use” as
 26 an affirmative defense. Shortly thereafter, X17 filed its FAC wherein it asserted a
 27 second claim for relief: “hot news” misappropriation. The FAC also increased the
 28 number of photographs that Lavandeira had allegedly infringed to 87. Once again,

1 X17 failed to attach either the photographs or the copyright registrations/applications.

2 **C. X17 Reluctantly Produces “Evidence” To Support Copyright**
 3 **Ownership At The Preliminary Injunction Phase.**

4 On January 29, 2007, X17 moved for a preliminary injunction. (Declaration of
 5 Michael Amir, ¶ 2.) The only evidence X17 offered in its moving papers to support
 6 copyright ownership was the declaration of Brandy Navarre. (*Id.*, ¶ 5, Exhibit 88 to
 7 Compendium of Exhibits to Michael Amir Declaration (the “Compendium”).) X17,
 8 for instance, failed to attach copyright registration certificates or at least applications
 9 for the same to its moving papers. Furthermore, X17’s moving papers contained no
 10 assignment agreements between it and its photographers regarding ownership of the
 11 copyrights. The only “evidence” going to copyright ownership was the following
 12 statement in Ms. Navarre’s declaration: “X17 owns the copyrights to all the images
 13 in [its] archive, including all of the photographs at issue in this case, as they are
 14 works made-for-hire.” (Exhibit 88 to Compendium, emphasis added.)

15 Lavandeira’s opposition to the motion for a preliminary injunction highlighted
 16 X17’s evidentiary deficiencies and the fact that X17 had failed to demonstrate
 17 copyright ownership. In its reply, X17 finally came forward with the following
 18 documents: (1) copies of the photographs to which it claimed ownership; (2) copies
 19 of the copyright applications; and (3) copies of purported assignment agreements
 20 between X17, on the one hand, and the photographers, on the other. (Amir Decl., ¶¶
 21 2, 5, Exs. 1-87 to Compendium.)

22 On March 6, 2007, this Court denied X17’s motion for preliminary injunction
 23 in its entirety. (*See* May 6, 2007 Order, Ex. 89 to Compendium [“Because of
 24 evidentiary defects in Plaintiff’s papers, Plaintiff has not met its burden of
 25 persuasion.”]) In its Order, the Court made the following finding with respect to the
 26 purported assignment agreements that were attached to Ms. Navarre’s declaration in
 27 support of X17’s reply: “X17 makes not the slightest mention of who created the
 28 documents, or how (and for what consideration) the assignments were obtained, or

1 even whether their signatories held legitimate claims to the copyrights in question.”
 2 (*Id.* at p. 3.)

3 **D. X17 Identifies Itself As The “Author” Of The Copyrights.**

4 **1. X17 Represents The Photographs As “Works Made For**
 5 **Hire.”**

6 The copyright application is a two-page document that contains nine separate
 7 spaces or fields. (Form VA Application, Compendium Ex. 99.) Space 2 concerns
 8 ownership of the work. (*Id.*) In particular, the applicant is asked whether the subject
 9 is a “work made for hire.” (*Id.*) The copyright application also contains detailed,
 10 line-by-line instructions for applicants to follow. (*Id.*) The instructions for space 2
 11 state:

12 **Name of Author:** The fullest form of the author’s name should be
 13 given. Unless the work was “made for hire,” the individual who
 14 actually created the work is its “author.” In the case of a work made for
 15 hire, the statute provides that “the employer or other person for whom
 the work was prepared is considered the employer.”

(Ex. 98 to Compendium, emphasis added.)

16 X17 produced the copyright applications as part of its reply to the preliminary
 17 injunction motion. (*See* Exhibits 1-87 to Compendium.) In each of the copyright
 18 applications, X17 identifies itself as the “Author” and represents that the photograph
 19 was a “work made for hire.” (*Id.*) The applications contain no information
 20 whatsoever about the actual photographers. (*Id.*) The applications also make no
 21 reference to any assignment agreements. (*Id.*) The applications were all completed
 22 by X17’s litigation counsel in this case, the law firm of Turner Green Afrasabi &
 23 Arledge. (*Id.*)

24 **2. X17 Creates Assignment Agreements For This Lawsuit.**

25 In a last-ditch effort to salvage its motion for a preliminary injunction, X17
 26 produced purported “assignment agreements” between the photographers who
 27 actually took the photographs and X17. (*See* Exs. 1-87 to Compendium.) It is
 28 undisputed that X17 created these agreements solely as a matter of litigation strategy.

1 Indeed, when deposed, the photographers admitted that they only signed the
2 assignment agreements in order to assist X17 in the pending lawsuit against
3 Lavandeira.

4 Q. Let me try to see if I get what you are saying. Your understanding in
5 signing Exhibit 129 (the assignment agreement) was to help
6 [Francois Navarre] and X17 in a lawsuit; correct?

7 A. Right.

8 Q. Was there any other purpose or reason for you signing Exhibit 129?

9 A. No.

10 (Ruano Depo. at 34:17-23, Ex. 94 to Compendium.; *see, also*, Bebey Depo. at 52:22-
11 25, Ex. 90; Mariotto Depo. at 23:6:19, Ex. 91; Sanchez Depo. at 38:8-39:12; 43:4-11,
12 Ex. 92; Merino Depo. at 9:18-25, Ex. 93; Filho Depo at 17:11-18:2, 34:15:-18, Ex.
13 101 to Compendium.)

14 The photographers also testified that they have signed no written agreements
15 with X17, other those signed in connection with this litigation. (*See* Bebey Depo.
16 40:16-41:8, Ex. 90 to Compendium; Mariotto Depo. at 23:6:19, Ex. 91; Merino
17 Depo. at 11:14-12:6, Ex. 93; Ruano Depo. at 11:25-12:5, Ex. 94, Filho Depo at
18 18:20-19:14, Ex. 101 to Compendium.)

19 In its rush to have the photographers sign assignment agreements to bolster
20 their flagging claims in the lawsuit, X17 had two photographer assign rights to
21 photographs which he did not even take. In particular, photographer Carlos Ruano
22 executed an assignment in favor of X17 with respect to four photographs. (*See*
23 Exhibit 129 of Ruano Depo. attached as Ex. 94 to Compendium.) At his deposition,
24 Mr. Ruano testified that he actually did not take two of the four photographs²
25 identified in the assignment agreements:

26 BY MR. AMIR: I'm going to give you Exhibit 128 and have you take a
27 look at the picture

28 ² The four photographs are attached as Exhibit 128 (a) through (d) to the Ruano deposition,
which are now attached as Exhibit 96 to the Compendium.

1 (Defendant's Exhibit 128 was marked for identification by the court
reporter and attached hereto.)

2 THE DEPONENT: This one is not me.

3 BY MR. AMIR: No, that was not me (indicating).

4 Q. Okay.

5 A. This one is (indicating) – this one I – it wasn't me either.

6 Q. Are you sure?

7 A. I was there doing the video though, I remember.

8 Q. So, this is, for the record, B, you don't think you took that one?

9 A. No.

10 (Ruano at 13:23-14:15; 39:2-41:8, Ex. 94 to Compendium.)

11 Likewise, photographer Felix Filho testified that he did not take two of the
12 pictures that he "assigned" to X17. (Filho Depo. at 36:23-37:3, Exs. 101-103 to
13 Compendium.)

14 3. X17 Fails To Disclose The Purported Assignment Agreements 15 To The Copyright Office.

16 Space 4 in the application asks the claimant whether ownership was acquired
17 by a transfer. (See VA Form, Ex. 99 to Compendium, ["If the claimant(s) named
18 here in space 4 is (are) different from the author(s) named in space 2, give a brief
19 statement of how the claimant(s) obtained ownership of the copyright"].) The
20 instruction for space 4 specifically advises the claimant to reveal whether ownership
21 was acquired through an assignment:

22 **Transfer:** The statute provides that, if the copyright claimant is not the
23 author, the application for registration must contain a "brief statement of
24 how the claimant claimed ownership of the copyright." If any copyright
25 claimant named in space 4 is not an author named in space 2, give a
brief statement explaining how the claimant(s) obtained ownership of
the copyright. Examples: "By written contract;" "Transfer of rights by
author;" Assignment;" "By Will;"

26 (Form VA Instructions, Ex. 98 to Compendium, emphasis added.)

1 Notwithstanding the plain language of the application and the detailed
 2 instructions thereto, X17 made no reference of the actual photographers or the
 3 purported assignments. Thus, X17's only source of ownership, at least as revealed to
 4 the United States Copyright Office, was through the "work made for hire" doctrine.

5 **4. X17 Did Not Pay Photographers Any Consideration For**
 6 **Signing The Assignments.**

7 Each of the assignment agreements states that "FOR GOOD AND
 8 VALUABLE CONSIDERATION," the photographers assign all of their rights to
 9 X17. (*See* Exs. 1-87 to Compendium.) At their depositions, however, the
 10 photographers testified that X17 did not pay them any money in exchange for signing
 11 the assignment agreements. (*See* Bebey Depo., at 57:6-58:10; Mariotto Depo. at
 12 35:4-21; Sanchez Depo. at 61:9-23; and Merino Depo. at 48:7-21; Filho Depo. at
 13 51:21-52:10, Ex. 101 to Compendium.)

14 **E. None Of The Photographers Are X17 Employees.**

15 Both X17 and the photographers who took the photographs at issue have
 16 testified that the photographers are not employees, but rather independent
 17 contractors. For instance, X17's principal, Francois Navarre, testified at his
 18 deposition that X17 has no employees:

19 Q. Does X17 have any employees?

20 A. Not at this time. We're in the process of doing it, but I don't
 21 know where we are in that, so I don't think it's fully (sic)
 employees at this time, not yet, no.

22 (Navarre Depo. at 167:19-23, Ex. 97 to Compendium.)

23 The photographers confirmed that they were independent contractors, not
 24 employees.

25 Q. You consider yourself an independent contractor or an employee
 26 of X17.

27 A. I'm independent contractor. I'm totally – how can I say that? I
 28 just deal with X17 only. That's it.

1 Q. All right. You consider yourself an independent contractor; isn't
2 that correct?

3 A. Yes.

4 (Mariotto Depo. at 17:11-13, Ex. 91 to Compendium; *see also* Bebey Depo. at 8:24-
5 12:18, Ex. 90 to Compendium)

6 The following is an excerpt from David Sanchez, the photographer who
7 purportedly took many of the photographs:

8 Q. Do you consider yourself an employee of X17?

9 A. No self-employed.

10 Q. Do you consider yourself an – have you heard of the term “independent
11 contractor?”

12 A. Yeah.

13 Q. That's what you consider yourself?

14 A. Uh-huh.

15 Q. Yes?

16 A. Yes.

17 (Sanchez Depo. at 18:13-21, Ex. 92 to Compendium.)

18 Finally, the following is from photographer Carlos Ruano's depositions:

19 Q. Are you an employee of X17?

20 A. He considers me as a freelance.

21 Q. Who considers you as a freelance?

22 A. [Francois Navarre] and pretty much me, I guess, when I do my taxes, that's
23 the way I claim them.

24 Q. So you claim yourself as an independent contractor; right?

25 A. Right.

26 (Ruano at 9:21-10:3, Ex. 94 to Compendium; *see also* Filho Depo. at 8:3-12, Ex. 101
27 to Compendium)

28

1 **F. X17 And Lavandeira Are Not Competitors.**

2 X17's business is separated into two separate parts: (1) licensing photographs
3 to media outlets; and (2) operating an online website. (Navarre Depo. at 99:11-19,
4 Ex. 97 to Compendium.) In his deposition, Francois Navarre, X17's principal,
5 identified all of X17's competitors with respect to its licensing business. Mr. Navarre
6 never even mentioned Lavandeira:

7 Q. So let's start with the sale of photographs, that part of your business
8 – is it fair to call that X17 agency?

9 A. Yes.

10 Q. So as to X17 agency, who are the competitors?

11 A. Competitors are Wire Image, Splash agency, There's another one
12 smaller, but still going, its Bower Griffin. Zuma. There's one called
13 Zuma. What else? I mean sometimes we compete with AP. AP's,
they are too Highlatores in (inaudible) or so. There's smaller one
called Flynet. Going smaller and smaller, Ramie Productions or
something.

14 (Navarre Depo. at 99:20-100:6, Ex. 97 to Compendium.)

15 In reality, Lavandeira cannot be a competitor of X17's in the licensing
16 business because he is not in that business. (Lavandeira Decl. ¶ 7.) Accordingly, it
17 cannot be disputed that he is not a competitor of X17's with respect to licensing.

18 X17 also has conceded that Lavandeira is not its competitor with respect to its
19 online business:

20 Q. Oh, no. Now I've moved on to on-line.

21 A. X17, on-line, okay, so that's different. The competitor for X17 on-
22 line from my point of view, the main competitor is TMZ.

23 Q. Any other competitors?

24 A. After that would come People.dot.com and after that there is a lot of
small websites like entertainment go see websites.

25 (Navarre Depo. at 101:20-102:2, Ex. 97 to Compendium.)

26 Not only did X17 not identify Lavandeira as a competitor in the online
27 business, when specifically asked whether Lavandeira is a competitor, X17
28

1 affirmatively testified that Lavandeira was not its competitor and that the two
2 websites serve different purposes:

3 Q. And does X17 on-line dot com compete with Perez Hilton dot com?

4 A. I think it's a different type of blog; I don't see – I see other blogs that
5 are competitors but not him.

6 Q. So you don't see Perez Hilton dot com as a competitor of X17 on
7 line; is that correct?

8 A. It's a competitor when he steals our picture.

9 Q. So where Perez Hilton do – and I'm just – I want to limit it to the
10 website for now and is not Mr. Lavandeira, but I'm trying to find out
11 if you believe that Perez Hilton dot com is similar to X17 on-line?

12 A. As far as he doesn't use our picture, it's not a competitor for me from
13 my point of view.

(Navarre Depo. at 36:25-38:15, Ex. 97 to Compendium.)

14 **III. THE SUMMARY JUDGMENT STANDARD**

15 Summary judgment is not “a disfavored procedural shortcut, but rather . . . an
16 integral part of the Federal Rules as a whole, which are designed to secure the just,
17 speedy and inexpensive determination of every action.” Celotex Corp. v. Catrett, 477
18 U.S. 317, 327 (1986). Summary judgment is proper when there is no genuine issue
19 of material fact and the moving party is entitled to judgment as a matter of law. Fed.
20 R. Civ. P. 56. Once the movant shows that there is no issue of fact, the burden shifts
21 to the respondent to show there is a genuine issue for trial. Anderson v. Liberty
22 Lobby, Inc., 477 U.S. 242, 250 (1986). Because no genuine issue of material fact
23 exists in this matter, Lavandeira is entitled to summary judgment.

24 **IV. LAVANDEIRA IS ENTITLED TO SUMMARY JUDGMENT ON X17's** 25 **COPYRIGHT CLAIM**

26 Summary judgment should be granted on X17's copyright claim because the
27 undisputed facts demonstrate that its purported copyright registrations are invalid.
28 As discussed below, the law is clear that courts do not have subject matter
jurisdiction in copyright infringement cases premised on invalid registrations.

1 A. **X17's Copyright Registrations Are Invalid Because It Falsely Stated**
2 **To The Copyright Office That The Photographs Were Works Made**
3 **For Hire**

4 It is a fundamental tenet of copyright law that only the owner of a work can
5 lawfully register the work with the United States Copyright Office. *Morgan, Inc. v.*
6 *White Rock Distilleries, Inc.*, 230 F.Supp.2d 104 (D. Me. 2002) ("It is only the
7 copyright *owner* that may apply for [copyright] registration."). Thus, a copyright
8 registration based on an application submitted by one who does not own the work at
9 issue is invalid as a matter of law. *Morgan*, 230 F.Supp.2d at 108-09 (holding that
10 because the party submitting the copyright application was not the lawful owner of
11 the works when he submitted the application, the registrations were invalid).

12 Here, X17 represented to the Copyright Office that it was the owner of the
13 photographs at issue based on the doctrine of "work for hire." However, the
14 undisputed facts demonstrate that there was no factual or legal basis for this
15 representation. In particular, Sections 101(1) and (2) of the Copyright Act provide
16 that a work may be "for hire" only in two specific circumstances: (1) "a work
17 prepared by an employee within the scope of his or her employment;" or (2) certain
18 works "specially ordered or commissioned." *See Community for Creative Non-*
19 *Violence v. Reid*, 490 U.S. 730, 109 S.Ct. 2166, 2177-78 (1989). Neither of these
20 circumstances existed when X17 submitted its copyright applications.

21 **1. The Photographers Were Not Employees Of X17**

22 It is undisputed that the photographers who took the photographs were not
23 employees of X17. In fact, Francois Navarre unequivocally admitted at his
24 deposition that X17 has no employees. (Navarre Depo. at 167:19-23.) Significantly,
25 the photographers testified that they were independent contractors for X17, not
26 employees. (Mariotto Depo. at 17:11-13; Bebey Depo. at 8:24-12:18; Sanchez Depo.
27 at 18:13-21; Ruano Depo at 9:21010:30; Filho Depo. at 8:3-12.) The law is clear that
28 independent contractors are not employees for purposes of Section 101(1).

1 *Community for Creative Non-Violence*, 490 U.S. at 753. Thus, the Supreme Court
 2 held in *Community for Creative Non-Violence* that the only way an independent
 3 contractor can create a “work for hire” is to satisfy the requirements of Section
 4 101(2). *Id.*

5 **2. The Photographs Were Not Specially Ordered Or Commissioned** 6 **Works Under Section 101(2)**

7 The only other way X17 may invoke the “work for hire doctrine” is if it
 8 establishes that X17 “specially ordered or commissioned” the photographs as defined
 9 by Section 101(2). Here, X17 had no legal or factual basis for claiming that the
 10 photographs fall within Section 101(2). In particular, Section 101(2) has two
 11 independent requirements: (1) the work must fall within nine listed categories of
 12 works; and (2) the parties must have agreed in writing that the work would be a work
 13 for hire. *Community for Creative Non-Violence*, 490 U.S. at 738. Here, X17 cannot
 14 satisfy either requirement.

15 First, the photographs plainly do not fall within any of the nine following
 16 categories:

- 17 (1) a contribution to a collective work;
- 18 (2) a part of a motion picture or other audiovisual work;
- 19 (3) a translation;
- 20 (4) a supplementary work;
- 21 (5) a compilation;
- 22 (6) an instructional text;
- 23 (7) a test;
- 24 (8) answer material for a test; or
- 25 (9) an atlas.

26 17 U.S.C. § 101(2).

27 Second, X17 has not come forward with any evidence that X17 and the
 28 photographers entered into written “work for hire” agreements whereby X17
 “specially ordered or commissioned” the photographs. Indeed, the photographers
 testified that the “assignment agreements” were the only written agreements they
 signed with X17, and these agreement plainly are not “work for hire” agreements.
 (Compendium, Exs. 1-87.)

1 Thus, X17 could not, as a matter of law, validly claim ownership rights to the
 2 photographs based on the “work for hire doctrine.” As such, it was not the lawful
 3 owner of the photographs when it submitted the applications, and thus any resulting
 4 registrations are invalid as a matter of law. See, *Morgan*, 230 F.Supp.2d at 108-09
 5 (because the party submitting the copyright application was not the lawful owner of
 6 the works when he submitted the application, the registrations were invalid).

7 **B. An Invalid Copyright Registration Nullifies The Court’s Subject**
 8 **Matter Jurisdiction In An Infringement Action.**

9 Because X17’s copyright registrations are invalid, the Court has no subject
 10 matter jurisdiction over this case. The “predominant rule is that an invalid
 11 registration (involving material errors, fraud, or an incomplete application) nullifies
 12 the federal court’s subject matter jurisdiction.” *Torres-Negron v. J&N Records, LLC*,
 13 Nos. 06-2058, -2059, 2007 WL 2846117, at *7 (1st Cir. Oct. 2, 2007) (slip op.).
 14 Indeed, “in cases where a plaintiff’s copyright registration has been invalidated
 15 because of a finding of fraud or intentional misrepresentation on the registration
 16 application, numerous district courts and the Second Circuit have concluded that the
 17 plaintiff’s copyright is simply ‘unenforceable’ and have dismissed the claims without
 18 discussion of the merits[,] again indicating that a valid registration is necessary for
 19 federal jurisdiction.” *Id.* at *8 (citations omitted).

20 Subject matter jurisdiction was found to be lacking on facts strikingly similar
 21 to the instant case in *Morgan, supra*. In that case, the plaintiff alleged that “Morgan
 22 Howarth filed the photographs at issue with the United States Copyright Office and
 23 obtained copyright registration for the photographs” in the name of Morgan
 24 Howarth. *Id.* at 108 (quoting the complaint). The question, then, was “whether Mr.
 25 Howarth was the owner of the copyright in the subject photographs at the time he
 26 registered them so that the registration had legal effect.” *Id.* The complaint also
 27 alleged that the copyrights in the photographs belonged to Morgan, Inc. pursuant to
 28 the work for hire doctrine, which meant that “Morgan, Inc. was the author and owner

1 of the works from the moment of their creation.” *Id.* Thus, “based on the allegations
 2 in the Amended Complaint[,] the copyright registration by Mr. Howarth, in the name
 3 of Mr. Howarth, who was not the author or owner of the copyright at the time of the
 4 registration, ha[d] no legal effect.” *Id.*

5 The plaintiffs in *Morgan* argued that this was an inadvertent “misstatement or
 6 error on the registration application, as a result of Mr. Howarth completing the
 7 copyright registration documents without the assistance of counsel.” *Id.* The court,
 8 however, rejected this argument. *Id.* The court elaborated as follows:

9 First, given that to date Plaintiffs have founded their copyright
 10 infringement claim on three different factual theories of copyright
 11 ownership and registration, the Court does not believe that the
 12 registration contains any misstatement. Moreover, the Court finds the
 13 instructions on the registration documents quite clear with respect to
 who the owner is when the work is created by an employee and
 specifically asking if this was a work “made for hire.”

14 230 F. Supp. 2d at 108. Thus, Morgan, Inc. was not the “lawful owner” of the
 15 copyrights when it registered them, and the court was therefore without jurisdiction
 16 to hear the copyright claim. *Id.* at 109.

17 Here, as discussed above in Section IV.A., X17 applied for the copyrights to
 18 the photographs based on the work for hire doctrine, without any factual basis for its
 19 claim that the photographs were works for hire. Based on these misrepresentations,
 20 and the fact that X17 was not in fact the owner of the photographs at the time it
 21 sought the registrations, X17’s registrations are invalid as a matter of law. Because
 22 the registrations are invalid, the Court lacks subject matter jurisdiction, and thus
 23 Lavendeira is entitled to summary judgment on X17’s first claim for relief for
 24 copyright infringement.

25 **V. X17’S PURPORTED ASSIGNMENT AGREEMENTS DO NOT CURE**
 26 **X17’S INVALID REGISTRATIONS.**

27 Despite its unequivocal representation to the Copyright Office that its
 28 photographs were “works for hire,” X17 has produced in this litigation numerous

1 purported “assignment agreements.” X17’s position appears to be that if the Court
 2 finds that photographs were not works for hire, the Court nonetheless should deem
 3 the registrations valid based on these assignment agreements. This argument lacks
 4 merit for several reasons.

5 **A. X17 Failed To Submit The Assignment Agreements To The**
 6 **Copyright Office**

7 The validity of X17’s purported copyrights depends not on what X17 produces
 8 in this litigation, but rather on what it represents to the Copyright Office. In its
 9 copyright applications, X17 clearly represented that the photographs were works for
 10 hire, not that it obtained ownership rights through assignment. Moreover, while the
 11 Copyright Act does permit supplementary registration to correct mistakes in
 12 registration (*see* 17 U.S.C. § 408(d)), X17 has produced no evidence to demonstrate
 13 that it has filed any supplemental registration with the United States Copyright Office
 14 to explain that it was mistaken when it indicated that each of the 87 photos at issue
 15 here were “works made for hire.”³ This failure renders the purported assignment
 16 agreements meaningless. *See, Morgan*, 230 F.Supp.2d at 108 (failure to submit
 17 supplemental registration among factors requiring dismissal for lack of subject matter
 18 jurisdiction).

19 **B. Even If It Had Submitted The Assignments, X17 Cannot Use**
 20 **Supplementary Registration To Validate An Invalid Registration**

21 X17 cannot use supplementary registration as a vehicle to change the basis of
 22 its ownership from “work for hire” to assignment. Supplementary registration may not
 23 be used to reflect transfer of ownership. *See*, 37 C.F.R. § 201.5(b)(2)(iii); *Rubloff v.*
 24 *Donahue*, 31 U.S. P.Q.2d 1046, 1051 (N.D. Ill. 1994). In *Rubloff*, plaintiff in an

25
 26 ³ Lavandeira disputes that any inadvertent “mistake” was made here, as evidence
 27 demonstrates that X17’s experienced attorney intentionally described each of the 87
 28 photos as works for hire on the copyright registration forms despite knowledge that
 none of the photos were taken by X17 employees or pursuant to any written
 agreement to perform work for hire for X17.

1 infringement action was a company whose employees prepared portions of a training
 2 manual. The employees did not sign work for hire agreements with respect to the
 3 manual. The plaintiff nonetheless applied for, and obtained, a copyright registration
 4 of the manual as a work for hire. After the registration was issued, the plaintiff
 5 secured assignments from the employees. *Id.* at 1048. The defendant moved for
 6 summary judgment, arguing that the plaintiff's copyright was invalid as a matter of
 7 law because it did not own the copyrights at the time it applied for registration. The
 8 court agreed and granted the motion, holding that because the manual was not a work
 9 for hire as represented in the application, the registration was invalid. In reaching its
 10 holding, the court rejected plaintiff's argument that his effort to submit a
 11 supplemental registration based on the assignment was enough to save its claims. *Id.*
 12 at 1051.

13 So it is here – X17 submitted its applications based on a false claim that the
 14 photographs were works for hire. Because it did not in fact own the photographs
 15 under the work for hire doctrine, X17's registrations are invalid. Under the principles
 16 enunciated in *Rubloff*, X17 cannot now cure those defects by supplemental
 17 registration.

18 **C. For At Least 56 Photographs, The Purported Assignments**
 19 **Occurred After X17 Submitted The Copyright Applications, And**
 20 **Thus Partial Summary Judgment Is Appropriate**

21 Even if merely producing the assignment agreements in litigation were
 22 sufficient (which plainly is not the case), the assignment agreements produced by
 23 X17 would not save the invalid registrations. The majority of the assignment
 24 agreements are dated after the copyright applications were submitted. It is well-
 25 established that a party seeking to register a copyright must own that copyright at the
 26 time the application is submitted. *Konisberg Int'l v. Rice*, 16 F.3d 355 (9th Cir.
 27 1994). Moreover, as set forth in *Rubloff*, *supra*, assignment agreements obtained
 28 after registration cannot cure an invalid registration. 31 U.S.P.Q. at 1051. Thus,

1 even with the assignment agreements, X17 had no rights whatsoever to 54 of the
 2 photographs when it sought registration. Even worse, in at least two cases, the
 3 assignment agreements pertain to copyrights that were “transferred” by
 4 photographers who did not even take the photographs. Thus, at a minimum, partial
 5 summary judgment is appropriate for the following 56 photographs.

6 **1. The January 22, 2007 “Assignments”**

7 In particular, 36 of the photos were not “assigned” to X17 until January 22,
 8 2007 (*see*, Exhibits 2, 19, 20, 21, 22, 23, 24, 25, 34, 35, 36, 37, 55, 56, 57, 58, 59, 60,
 9 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77 and 78 (collectively
 10 the “January 22, 2007 Assigned Photos”)). Yet, X17 applied to register these
 11 photographs one month earlier on December 28, 2006. (*see, id.*) Because X17 had no
 12 ownership rights at the time of registration, it had no right to file the applications for
 13 the 36 January 22, 2007 Assigned Photos, and thus the registrations for those photos
 14 have no legal effect. *Morgan*, 230 F.Supp.3d at 107. This Court lacks subject matter
 15 jurisdiction with respect to the claims based on each of those thirty-six photos, and
 16 thus, at a minimum, partial summary judgment is warranted with respect to those
 17 photographs.

18 **2. The Undated November 2006 “Assignments”**

19 X17 also failed to establish that it had ownership rights with respect to
 20 seventeen photographs purportedly assigned pursuant to assignment agreements from
 21 November 2006. X17 submitted those photos to the United States Copyright Office
 22 on November 27, 2006 (exhibits 30, 32, 33, 46, 47, 48, 49, 50, 51, 52, 53 and 54) and
 23 November 28, 2006 (exhibits 26, 27, 28, 29 and 31). X17 had no ownership rights
 24 prior to entering into assignment agreements with the photographers that took the
 25 these photographs. The assignment agreements X17 produced in connection with
 26 each of those photographs are undated, containing the blank designation, “effective
 27 as of the ___ day of November, 2006.” (Exs. 26, 27, 28, 29, 30, 31, 32, 33, 46, 47, 48,
 28 49, 50, 51, 52, 53 and 54). Because X17 has failed to establish that it obtained the

1 assignments of ownership rights with respect to the undated November 2006
 2 Assigned Photos prior to the dates it sought registration, the registrations for those
 3 photos are invalid as well. (*Id.*) This Court lacks subject matter jurisdiction with
 4 respect to the claims based on each of those seventeen photos and thus, at a
 5 minimum, partial summary judgment is warranted with respect to those photographs.

6 **3. The Improperly Assigned Photographs**

7 X17 purports to assert ownership rights in four photographs (Exhibits 82, 83,
 8 102 and 103 to Compendium) as a result of an assignment agreement signed by
 9 photographer Carlos Ruano. However, at their depositions, Messrs. Ruano and Filho
 10 testified that they did not take those photos.⁴ (Ruano at 13:23-14:15; 39:2-41:8;
 11 Filho Depo. at 36:23-37:3.) Nonetheless, X17 purports to assert ownership rights in
 12 those photos as a result of an assignment agreement with Messrs. Ruano and Filho.
 13 (Exs. 82, 83, 102.) Because these two had no rights to assign to X17, the purported
 14 assignment agreements are ineffective, rendering the registration for Exhibits 82, 83,
 15 102 and 103 even more invalid. *Morgan* at 107. This Court lacks subject matter
 16 jurisdiction with respect to the claims based on each of those photos and thus, at a
 17 minimum, partial summary judgment is warranted with respect to those photos.

18 **VI. AT A MINIMUM, X17 IS NOT ENTITLED TO STATUTORY** 19 **DAMAGES, AS IT FAILED TO FILE FOR REGISTRATION PRIOR** 20 **TO THE ALLEGED INFRINGEMENT (OR WITHIN THE THREE** 21 **MONTH GRACE PERIOD).**

22 **A. The Requirements For Statutory Damages And Attorneys' Fees.**

23 In the event the Court does not dismiss X17's copyright claims, it should grant
 24 partial summary judgment on the issue of statutory damages and attorneys' fees. In
 25 order to qualify for such relief, the work at issue must be registered with the United
 26 States Copyright Office prior to the commencement of the infringement. *See Berlyn*,

27 ⁴ Exhibits 82 and 83 to the concurrently filed Compendium were part of Exhibit 94. The
 28 assignment agreement was attached as Exhibit 129 to Mr. Ruano's deposition.

1 *Inc. v. Gazette Newspapers, Inc.*, 157 F. Supp. 2d 609, 624 (D.Md. 2001).

2 “Commencement” of the infringement means “the time when the first act of
3 infringement in a series of ongoing discrete infringements occur.” *Johnson v. Jones*,
4 149 F.3d 494, 505-06 (6th Cir. 1998). Here, with respect to each of the 87 photos at
5 issue in this case, X17’s registration application was not submitted until after the
6 commencement of the purported infringement. (See Exhibit 1-87; FAC ¶¶ 13-58.)

7 **B. It Is Undisputed That X17 Cannot Meet The Requirements For**
8 **Statutory Damages And Attorneys’ Fees On At Least 18**
9 **Photographs.**

10 Although the Copyright Act allows for a three-month grace period to register
11 after the first publication, *see* 17 U.S.C. § 412, X17 applied for registration well after
12 the three-month grace period with respect to 18 of the photographs at issue here. As
13 a result, X17 is not entitled to statutory damages and attorneys fees with respect to
14 each of the following photos:

- 15 • Exhibit 6. X17 represented to the United States Copyright Office that
16 the date of first publication for this photo was December 5, 2004. X17
17 filed its application for registration on November 28, 2006, well after the
18 three month grace period.
- 19 • Exhibit 7. X17 represented to the United States Copyright Office that
20 the date of first publication for this photo was October 8, 2004. X17
21 filed its application for registration on November 27, 2006, well after the
22 three month grace period.
- 23 • Exhibit 8. X17 represented to the United States Copyright Office that
24 the date of first publication for this photo was July 31, 2005. X17 filed
25 its application for registration on November 28, 2006, well after the
26 three month grace period.
- 27 • Exhibit 9. X17 represented to the United States Copyright Office that
28 the date of first publication for this photo was March 22, 2006. X17
filed its application for registration on November 27, 2006, well after the

1 three month grace period.

- 2 • Exhibit 10. X17 represented to the United States Copyright Office that
3 the date of first publication for this photo was March 22, 2006. X17
4 filed its application for registration on November 27, 2006, well after the
5 three month grace period.
- 6 • Exhibit 14. X17 represented to the United States Copyright Office that
7 the date of first publication for this photo was April 28, 2006. X17 filed
8 its application for registration on November 27, 2006, well after the
9 three month grace period.
- 10 • Exhibit 15. X17 represented to the United States Copyright Office that
11 the date of first publication for this photo was April 22, 2006. X17 filed
12 its application for registration on November 27, 2006, well after the
13 three month grace period.
- 14 • Exhibit 16. X17 represented to the United States Copyright Office that
15 the date of first publication for this photo was April 22, 2006. X17 filed
16 its application for registration on November 27, 2006, well after the
17 three month grace period.
- 18 • Exhibit 17. X17 represented to the United States Copyright Office that
19 the date of first publication for this photo was April 22, 2006. X17 filed
20 its application for registration on November 27, 2006, well after the
21 three month grace period.
- 22 • Exhibit 18. X17 represented to the United States Copyright Office that
23 the date of first publication for this photo was April 22, 2006. X17 filed
24 its application for registration on November 27, 2006, well after the
25 three month grace period.
- 26 • Exhibit 26. X17 represented to the United States Copyright Office that
27 the date of first publication for this photo was May 27, 2005. X17 filed
28 its application for registration on November 28, 2006, well after the
three month grace period.
- Exhibit 27. X17 represented to the United States Copyright Office that

1 the date of first publication for this photo was October 31, 2004. X17
2 filed its application for registration on November 28, 2006, well after the
3 three month grace period.

- 4 • Exhibit 28. X17 represented to the United States Copyright Office that
5 the date of first publication for this photo was October 31, 2004. X17
6 filed its application for registration on November 28, 2006, well after the
7 three month grace period.
- 8 • Exhibit 29. X17 represented to the United States Copyright Office that
9 the date of first publication for this photo was October 31, 2004. X17
10 filed its application for registration on November 28, 2006, well after the
11 three month grace period.
- 12 • Exhibit 39. X17 represented to the United States Copyright Office that
13 the date of first publication for this photo was May 29, 2006. X17 filed
14 its application for registration on November 27, 2006, well after the
15 three month grace period.
- 16 • Exhibit 53. X17 represented to the United States Copyright Office that
17 the date of first publication for this photo was February 24, 2006. X17
18 filed its application for registration on November 27, 2006, well after the
19 three month grace period.
- 20 • Exhibit 54. X17 represented to the United States Copyright Office that
21 the date of first publication for this photo was February 24, 2006. X17
22 filed its application for registration on November 27, 2006, well after the
23 three month grace period.
- 24 • Exhibit 79. X17 represented to the United States Copyright Office that
25 the date of first publication for this photo was January 17, 2005. X17
26 filed its application for registration on November 29, 2006, well after the
27 three month grace period.
- 28

C. **Partial Summary Judgment Is Appropriate On The Issue Of Statutory Damages And Fees.**

Partial summary judgment is appropriate where, as here, the plaintiff fails to meet the prerequisites for statutory damages and attorneys' fees. *See Qualey v. Caring Center of Slidell*, 942 F. Supp. 1074 (E.D.La. 1996). In *Qualey*, Defendants moved for summary judgment on the issue of plaintiff's entitlement to statutory damages and attorneys fees. Defendants argued no entitlement to statutory damages because the allegedly infringing conduct took place prior to registration, as well as prior to first publication (plaintiff registered with the copyright office on June 14, 1994 and June 17, 1994; the date of first publication was March 25, 1994; the allegedly infringing conduct took place in October of 1993). The Court granted the motion for summary judgment in part, holding that "plaintiff is precluded from recovering statutory damages or attorneys fees for any infringement of the technical drawings. . . defendants are entitled to judgment as a matter of law in their favor on that issue." *Id.* at 1077.

Johnson v. University of Virginia, 606 F. Supp. 321, 324 (D.C.Va. 1985) also is on point. There, the Defendants filed motions to dismiss and motions for summary judgment. With respect to the statutory damages claim, defendants argued that registration took place after the alleged infringement and after the 3 month grace period (the photographs at issue here were not registered until March 12, 1984; date of first publication was September 2, 1983; the alleged infringement took place in January 1984), and thus plaintiffs were not entitled to statutory damages. Plaintiff argued that his claim for statutory damages was not barred because defendants continued to infringe following registration. The court held, however, that the alleged post-registration infringements involved the same photographs allegedly infringed in January of 1984. "Consequently, those alleged post-registration infringements 'commenced' prior to registration, and thus pursuant to § 412, they provide no basis for allowing statutory damages or attorney's fees." *Id.* at

1 325. The Court concluded: "Therefore, the court rejects plaintiff's arguments, and
 2 grants defendants' motions insofar as they request that plaintiff's claim for statutory
 3 damages and attorney's fees be denied." *Id*; see also *William A. Graham Co. v.*
 4 *Haughey*, 430 F. Supp. 2d 458 (E.D.Pa. 2006) (court granted the motion for summary
 5 judgment in part, as there was no dispute that, with respect to some of the claims, the
 6 alleged infringement took place prior to registration).

7 Here, the Court should grant partial summary judgment (i.e., strike the request
 8 for statutory damages and attorneys' fees) on the 18 photographs discussed above
 9 because X17 has not, as a matter of law, satisfied the statutory requirements.

10 **VII. LAVANDEIRA IS ENTITLED TO SUMMARY JUDGMENT ON X17'S**
 11 **"HOT NEWS" CLAIM.**

12 X17 cannot prevail on its claim for misappropriation of "hot news." X17 bases
 13 that claim on *National Basketball Assn. v. Motorola*, 105 F.3d 841 (2d Cir. 1997)
 14 ("*NBA v. Motorola*"), which concerned a claim for "hot news" misappropriation
 15 under New York state law. Two key elements of that claim are (1) the defendant's
 16 use of the information is in direct competition with a product or service offered by
 17 the plaintiff; and (2) the ability of others to free-ride on the efforts of the plaintiff
 18 would so reduce the incentive to produce the product or service that its existence
 19 would be substantially threatened. *Id.* at 852.

20 The undisputed facts establish that X17 cannot meet the foregoing two
 21 elements. For example, X17 has admitted that it is not Lavandeira's competitor,
 22 much less his "direct competitor." In order to satisfy this element, X17 must show
 23 that Lavandeira competes with X17 in its primary market. *NBA v. Motorola*, 103
 24 F.3d at 853 ("[a]ppeals to the misappropriation doctrine are almost always rejected
 25 when the appropriation does not intrude on the plaintiff's primary market," quoting
 26 *Restatement (Third) of Unfair Competition*, § 38). Here, there is no evidence to
 27 support the argument that the two are competitors. Indeed, the evidence is to the
 28 contrary, *i.e.*, that they are not competitors. (See Navarre at 36:25-38:15.)

1 X17 also cannot prove the other element of a “hot news” misappropriation
 2 claim – namely, that its “existence would be substantially threatened” by Lavandeira.
 3 This element requires that “defendant’s actions must make plaintiff virtually cease to
 4 participate in the business in question.” *Fred Wehrenberg Circuit of Theatres v.*
 5 *Moviefone*, 73 F.Supp.2d 1044, 1050 (E.D. Mo. 1999); *see also, International News*
 6 *Association v. Associated Press*, 248 U.S. 215, 241 (1981) (defendant’s actions must
 7 render the production and publication “profitless or so little profitable so as to cut off
 8 the service by rendering the cost prohibitive in comparison with the return”) The
 9 undisputed evidence demonstrates that X17 has not ceased “to participate in the
 10 business in question.” X17 has come forward with no evidence to suggest that X17’s
 11 business has even been harmed by Lavandeira. More importantly, X17 has failed to
 12 come forward with any evidence to support the proposition that Lavandeira is driving
 13 X17 out of business. The Court should accordingly dismiss the second claim for
 14 relief.

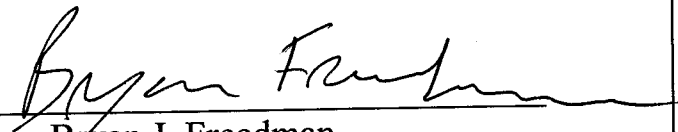
15 **VIII. CONCLUSION**

16 For the foregoing reasons, defendant’s Motion for Summary Judgment, or in
 17 the alternative, Partial Summary Judgment, should be granted.

18 Dated: December 17, 2007

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